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In re Application of
Polan, et al.
Application No. 10/666,869
Filed: September 18, 2003
Attorney Docket No. CA920020062US1

ON PETITION

This is a decision on the "Petition to Withdraw the Holding of Abandonment", filed January 25, 2008."

The petition is **Granted**.

The above-cited application was held abandoned on after a proper response was received to an Office communication mailed September 14, 2007. A review of the application file did not reveal a communication mailed September 14, 2007. It assumed that the examiner meant to hold the application abandoned for failure to seek further prosecution of the application after the mailing of the Decision on Appeal mailed May 30, 2007. A Notice of Abandonment was mailed January 11, 2008.

The instant petition was filed on January 25, 2008. In summary, petitioner maintains that after the Decision on Appeal, it was incumbent upon the examiner to take up the case for further consideration. A review of the application file reveals that the Board of Patent Appeal and Interferences reversed the examiner as to some claims, affirmed the examiner as to others, and entered a new ground of rejection.

It is noted that Section 1214.06 of the *Manual of Patent Examining Procedure (MPEP)*, provides in pertinent part, that:

The practice under the situations identified in paragraphs I-III below is similar to the practice after a decision of the court outlined in MPEP § 1216.01. Examiners must be very careful that case files that come back from the Board are not overlooked because every case, except applications in which all claims stand rejected after the Board's decision, is up for action by the examiner in the event no court review has been sought. See MPEP § 1216.01 and § 1216.02 for procedure where court review is sought.<

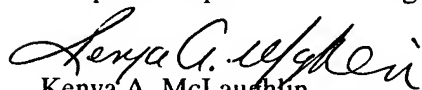
The time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the District of Columbia is the same for both tribunals, that is, 2 months, or 2 months with the extension provided by 37 CFR 1.304 in the event a request for rehearing is timely filed before the Board, or as extended by the *>Director<. See MPEP § 1216. When the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration.

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Except for a situation where no claims stand allowed, the MPEP 1214.06 dictates that the examiner must take appropriate action in the application depending on the circumstances. In this case, it appears that the examiner should have allowed a one-month period in which applicant could re-write the dependent claims in independent format and, if no response was received thereto, cancel all rejected claims issue the application with the allowed claims. It is noted that on July 18, 2007, the examiner conducted an interview with petitioner and inquired as to whether petitioner would approve an examiner's amendment to put dependent claims 5 and 9 into independent form. Petitioner declined the examiner's amendment. Given the guidance of MPEP 1214.06, it would have been most appropriate for an action to be issued allowing a one month period in which applicant could re-write the dependent claims in independent form and, if petitioner did not respond to cancel all rejected claims and allow the application with only the allowed claims. There does not appear to be a precedence for the proper abandonment of this application at the point at which the application was determined to be abandoned. The holding of abandonment is withdrawn, accordingly.

The application file is being directed to Technology Center, GAU 2152 for further consideration in light of MPEP 1214.06.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.



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